PATENT CASE: **CN01472KB**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **STAMFORD** et al.

For Patent: **New Neuropeptide Y Y5 Receptor Antagonists**

Serial No.: **10/692,559**

Filed: **10/24/2003**

Examiner: Celia Chang

Group Art Unit: 1625

Schering-Plough Corporation
Kenilworth, New Jersey 07033

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22323-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement mailed on July 1, 2005, for the above-identified application, applicants respond as follows. A response to the restriction requirement was originally due on August 1, 2005. Applicants are filing this response with a request for a four-month extension of time, herein attached, thus making this response timely if filed on or before December 1, 2005.

The Examiner stated that Claims 1-21 are pending in the application.

The Examiner restricted the claims into six groups:

Group I covering claims 2-3 and 5 in part, drawn to bipiperidine compounds, X and Z are N, g is 0, of Formula I and reading generic claims 1, 9, 11, 20 and 21.

Group II covering claims 5, 6-8, 5 in part drawn to piperidine compounds, and reading on generic claims 1, 9, 11, 20 and 21.

Group III, covering claims 1, 9, 11, 20 and 21, drawn to X is N, g is not 0.

Group IV covering claims 10, 12-16, drawn to method of treating metabolic disorder, eating disorder or diabetes with single compound.

Group V covering claims 17 and 19 drawn to method of treating metabolic disorder, eating disorder or diabetes with multiple active ingredients.

Group VI, covering claim 18 drawn to method of treating metabolic disorder, eating disorder or diabetes with a first and second active compound.

The Examiner advised applicants to elect a Group to be examined and to identify the claims reading thereon, as well as elected a single disclosed species.

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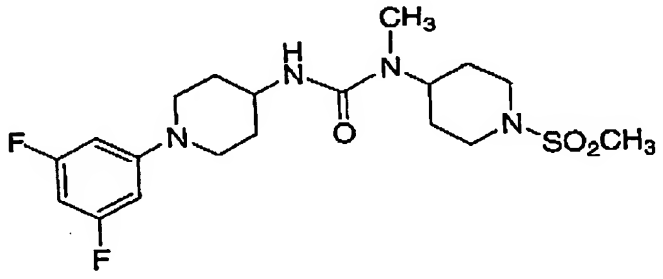
Applicants are puzzled by the restrictions of the claims by the Examiner and believe that claims 1-21 form part of one and the same invention. Applicants believe that when there is a linking generic claim encompassing the scope of all the compounds, pharmaceutical compositions comprising them and methods of treatment using them, it is inappropriate to restrict the invention to a single compound. Applicants also believe that due to such commonality a complete examination of claims 1-21 would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions. Applicants are equally confused as to why the methods of treatment that rely on the compounds and pharmaceutical compositions of elected Group I have been restricted out. Applicants also are of the belief that Groups I, II and III are so closely related that it would not cause an undue burden to the Examiner to examine them together. At a minimum, applicants respectfully suggest that those claims of Groups IV, V and VI that rely on the compounds of Group I, should NOT be restricted out of the pending application.

Reconsideration and withdrawal of the restriction requirement is therefore respectfully requested.

However, for the sake of facilitation of prosecution and in order to comply with the Examiner's requirement, Applicants initially elect the claims that the Examiner has identified as belonging to Group I, with traverse.

Further, applicants tentatively elect the following single species to be examined.



This compound is herein described on in claim 3 on pages 98 and 99.

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The Examiner is requested to call the undersigned attorney on any matter connected with this application.

Respectfully submitted,

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Date: November 30, 2005